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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,577	09/30/2003	August Joseph Borschke	11867/23	9964
757 7590 01/10/2008 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER CORDRAY, DENNIS R	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/675,577

Applicant(s)

BORSCHKE ET AL.

Examiner

Dennis Cordray

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 27-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/19/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly amended claims 27-49 are directed to an invention or species that is patentably distinct from the invention originally claimed for the following reasons:

Species I. Claims 1-26 are directed to a smokable rod comprising a core portion, which optionally comprises a burn suppressing agent, and an outer portion circumscribing the core portion, the outer portion comprising a burn suppressing agent such that the degree of burn suppression in the outer portion is higher than degree of burn suppression in the core portion.

Species II. Claims 27-49 are directed to a smokable rod comprising an outer portion, which optionally comprises a burn suppressing agent and which circumscribes a core portion, the core portion comprising a burn suppressing agent such that the degree of burn suppression in the core portion is higher than degree of burn suppression in the outer portion.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-49 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

Applicant's amendments and arguments, see pp 11-13, filed 10/29/2007, have been fully considered and are persuasive. Therefore, the previous rejections have been withdrawn. Muller et al teaches a low to medium permeability, With a preferred value of 0-60 CORESTA units. Henning et al (5058608) associates a low to medium permeability with a range of 15 to 40 CORESTA units (col 4, lines 29-30). Permeability values greater than 50 or 60 CORESTA units are taught in numerous references as relating to high permeability (Raker et al, 5085232, col 6, lines 13-15; Peterson et al, col 5, lines 13-19). Thus, one of ordinary skill in the art would not have considered a permeability of 100 CORESTA units to be in the low to medium range.

However, upon further consideration, new grounds of rejection are made as detailed below.

***Oath/Declaration***

The oath or declaration submitted 1/29/2004 is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

The originally submitted Oath recites the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56(a), rather than 37 CFR 1.56.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luke et al (5983901) in view of Jakob et al (5101839) and Mattina Jr. et al (4489739).

The following reference numbers relate to Luke et al, Fig. 4 and the description thereof in col 7, lines 17-50. Luke et al discloses a cylindrical smoking article comprising a rod of cut tobacco (longitudinally extending outer portion) 45 wrapped in a wrapper 43

and circumscribing a fuse portion (longitudinally extending core portion) 46 of cut tobacco, which is wrapped in a paper wrapper 47, and an optional filter (mouthpiece) 44. The inner core and outer portion are physically separated from one another by the wrapper for the fuse portion. In Example 1, a coaxial cigarette made according to the invention has a paper outer wrapper (col 8, lines 18-20 and 27-32). It is evident in the figure that the fuse portion, outer portion and both wrappers extend the length of the smoking article, thus are exposed at both ends.

The smoking article has a lighting end and a mouth end, which may contain a filter, opposite the lighting end.

The wrapper for the outer portion has a permeability of less than 20 CORESTA units, and the wrapper for the inner core has a permeability of 5-200 CORESTA units (col 4, lines 50-52), which overlaps the claimed "more than about 100 CORESTA units" or "more than about 200 CORESTA units."

The tobacco in the outer portion can be treated with a burn retardant, which is construed by the Examiner to mean that the tobacco is in intimate contact with the burn retardant or, at least, intimate contact would have been obvious to one of ordinary skill in the art.

Luke et al discloses that, when the article is lit, the fuse and body burn simultaneously. Burning from the lighted end toward the mouth end would have been obvious. When draw ceases, the body ceases to smoulder and either extinguishes completely or substantially extinguishes, while the fuse portion continues to smoulder

thus, in some embodiments, the degree of burn suppression in the outer portion is greater than in the fuse.

Luke et al discloses that the term "tobacco" embraces cut tobacco lamina and stem, tobacco subject to expansion processes (processed), reconstituted tobacco, and extruded tobacco (col 12, lines 23-33). Tobacco in cut filler form would have been obvious as a well known smokable material (for evidence, see Jakob et al, col 1, lines 12-15). No inorganic filler material is disclosed, thus the tobacco filler can be essentially all tobacco.

Luke et al does not disclose a binder, aerosol forming material or a salt exogenous to the tobacco material. Luke et al also does not disclose that the tobacco is cased or top dressed.

Jakob et al teaches that the use of aerosol forming materials in smoking articles is well known to add flavor (col 1, line 66 to col 2, line 3). Jakob et al discloses a smokable material comprising tobacco, an aerosol forming material (glycerin is exemplified) and a binder (alginate and guar gum are exemplified) to maintain the components together (col 2, lines 52-65). Jakob et al also teaches that casing and top dressing during cigarette manufacture are conventional processes known in the art (col 12, lines 16-18). The tobacco is an obvious substrate for additives and aerosol forming materials.

Mattina Jr. et al discloses that addition of an alkali metal salt of a carboxylic acid to tobacco reduces the production of undesirable carbon monoxide (Abs; col 1, lines 38-

43; col 2, lines 51-59). The salts at higher concentration can also act as burn retardants.

The art of Luke et al, Jakob et al, Mattina Jr. et al and the instant invention is analogous as pertaining to treatment of tobacco for smoking articles. It would have been obvious to one of ordinary skill in the art to include glycerin as an aerosol forming material in the tobacco in the outer portion of Luke et al in view of Jakob et al and Mattina Jr. et al as a well known flavor enhancer. Incorporating an alginate or guar gum as a binder in the outer portion would also have been obvious as typical additives known in the art to maintain the components together. Including an alkali metal salt of a carboxylic acid in the outer portion would have been obvious both to reduce carbon monoxide production and as a burn retardant. Casing and top dressing would have been obvious as conventional processes known in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Cordray whose telephone number is 571-272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
DRC

  
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